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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,559	12/19/2000	Bridget D. Kimball	D02311-P01	4506
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Motorola, Inc. Law Department 1303 East Algonquin Road 3rd Floor Schaumburg, IL 60196			EXAMINER DAVIS, ZACHARY A	
			ART UNIT 2137	PAPER NUMBER
			NOTIFICATION DATE 07/11/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/740,559

Applicant(s)

KIMBALL ET AL.

Examiner

Zachary A. Davis

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 10, 12 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 12 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A response to the Notices of Non-Compliant Amendment was received on 16 November 2007, concurrently with a Petition to Revive under 37 CFR 1.137(b), such petition being granted 29 February 2008. By the above response, Claims 9, 10, and 12 have been amended. Claims 11 and 13 have been canceled. New Claims 27-29 have been added. Claims 9, 10, 12, and 27-29 are currently pending in the present application.

Response to Arguments

2. Applicant's arguments filed 16 November 2007 have been fully considered but they are not persuasive.

Claims 9-11 and 13 were rejected under 35 U.S.C. 102(b) as anticipated by Wasilewski, US Patent 5420866. Claim 12 was rejected under 35 U.S.C. 103(a) as unpatentable over Wasilewski in view of McClellan et al, US Patent 5619250.

Regarding independent Claim 9, Applicant argues that "the disclosed invention should rightfully be claimed as a method directed to the conditional access of a separately received message within a conditional access system, and Claim 9 has been amended accordingly" and further asserts that, in contrast, "Wasilewski discloses a system for the provision of encrypted information to a set of decoders in a conditional access system, wherein the encryption information is specific to the particular 'stream'

of information in which it is inserted" (page 6 of the present response). First, the Examiner notes that the features upon which applicant relies (i.e., "conditional access of a separately received message") are not recited in the rejected claims. Although the claim recites in the preamble "A method for accessing a message", there is no indication that the message is "separately received" from anything. Further, there is no recitation in the claim of any message aside from the one recitation noted in the preamble. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, it is noted that it is not explicitly clear what such a message would be "separately received" from. Additionally, Although Applicant asserts that all of the present amendments are fully supported by the originally submitted application (page 6 of the present response), it is also noted that Applicant has not explicitly pointed out where in the disclosure such support may be found.

Further, in general, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant generally describes what Wasilewski discloses (page 6 of the present response), but does not appear to make any attempt to point out the language in the claims that distinguishes from the features of Wasilewski. The Examiner submits that, to the extent the presently amended claims can be interpreted due to the new issues of indefiniteness under 35 U.S.C. 112, second

paragraph, set forth below, Wasilewski still does appear to anticipate the invention as claimed in Claims 9, 10, 27, and 28, and the combination of Wasilewski and McClellan still appears to render obvious the invention as claimed in Claims 12 and 29, as detailed below.

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below and further sets forth new grounds of rejection for the new claims as applicable.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Each of the claims recites a "separately received content object". However, there does not appear to be proper antecedent basis for this limitation, specifically a "content object" in the specification. See below regarding the rejections under 35 U.S.C. 112, first paragraph, for failure to comply with the written description requirement.

Claim Objections

4. Claims 27 and 28 are objected to because of the following informalities:

Claim 27 recites "a video content" and Claim 28 recites "an audio content". The Examiner notes that the phrasing "a content" is not generally used; the more commonly used phrasing would be simply "content" or "contents". It appears that the claims should recite simply "video content" and "audio content" respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 9, 10, 12, and 27-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, each of the claims recites the limitation "separately received content object" and more particularly "content object". There does not appear to be sufficient written description for such a limitation. Although the specification refers in general to content, and that such content can include, for example, software (see page 3, line 10 of the present specification), and the disclosure further refers to "software objects" (see, for example, Figures 4 and 5, software object 408), it does not appear that all content would necessarily comprise

objects similar to the noted software objects. Therefore, there does not appear to be sufficient description of such a generalized "content object".

7. Regarding the rejections under 35 U.S.C. 112, second paragraph, the amendments to the claims have overcome the issues of indefiniteness noted in the previous Office action. However, the amendments also raise new issues of indefiniteness, and therefore the rejections are maintained.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 9, 10, 12, and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites a "separately received content object", for example, at line 5 of the claim. However, this is generally vague, as it is not clear what the object is received separately from; there is nothing in the claim to indicate what the object is separate from. Claim 9 further recites "receiving authorization information with a first conditional access receiver" in lines 3-4 and "receiving authorization information with a second conditional access receiver" in line 10; it is not clear whether this is the same authorization information received at both receivers. Further, the claim also recites "generating a first authorization for use of a separately received content object" in line 5; it is not clear if this is related to the received authorization information. Additionally, it does not appear that the authorization information and/or the first authorization are used

at all in the method. Although the claim also recites "performing a first determination to test if a first set top receiver is authorized to access the separately received content object" in lines 8-9 and "performing a second determination to test if a second set top receiver is authorized to access the separately received content object" in lines 11-12, it is not clear if the authorization information or first authorization are used in these determinations. Further, it is not clear whether the first and second "set top receivers" (for example, lines 8-9 and 11 respectively) are the same as the first and second "conditional access receivers" (lines 3-4 and 10 respectively), which would further affect how the claimed determinations were performed. All of the above renders the claim indefinite.

Claims 10, 12, and 27-29 similarly recite a "separately received content object", and are rejected by a similar rationale.

Claim 10 further recites "wherein blocking access to the separately received content object comprises..." in lines 2-3. However, because there are two steps of blocking access recited in Claim 9 (see lines 14-16, and again at lines 18-20), it is not clear to which of these two steps this is intended to refer, or if it is generally intended to refer to both steps.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 9, 10, 27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Wasilewski, US Patent 5420866.

In reference to Claim 9, Wasilewski discloses a method that includes receiving authorization information with a first conditional access receiver (column 14, lines 33-37), generating a first authorization for use of a content object a plurality of set top receivers (column 14, line 68-column 15, line 6), receiving the first authorization information at a first set top receiver (column 14, lines 33-37), performing a first determination testing if the first set top receiver is authorized to receive the content object (column 14, lines 62-65), receiving authorization information at a second conditional access receiver (column 14, lines 33-37; see also column 6, lines 38-43, where there are multiple receivers/decoders in multiple locations), performing a second determination testing if second a second set top receiver is authorized to receive the content object (column 14, lines 62-65; see also column 6, lines 38-43), blocking access of the content object in the first set top receiver if the first set top receiver is not authorized (column 14, line 68-column 15, line 6, where if a receiver is authorized, the program is output), and blocking access of the content object in the second set top receiver if the second set top receiver is not authorized (column 14, line 68-column 15, line 6).

In reference to Claim 10, Wasilewski further discloses ignoring a portion of a datastream associated with the content object (column 13, lines 60-63, where only some of the packets are extracted).

In reference to Claims 27 and 28, Wasilewski further discloses that the content comprises video or audio content (see, for example, column 8, lines 1-9).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 12 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski in view of McClellan et al, US Patent 5619250.

In reference to Claims 12 and 29, Wasilewski discloses everything as applied to Claim 9 above. However, Wasilewski does not specifically disclose that the content object includes a software program or firmware. McClellan discloses a system for television system set top boxes that includes receiving a software module sent from a central system in a set top box (column 7, lines 23-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the methods of Wasilewski to include sending software or firmware programs in the conditional access system, in order to allow for software modules to be downloaded

after the system has been initialized and to be functional upon receipt without the need for restarting the system (see McClellan, column 5, lines 10-14).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Conover et al, European Patent Application Publication EP 0200704, discloses a system for upgrading terminal software in a CATV system.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571)272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ZAD/
Examiner, Art Unit 2137

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2137